

REMARKS

Claims 1-21 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added. Applicants further submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objection to the Specification

On November 7, 2003, Applicants addressed the Examiner's objection to the Supplemental Combined Declaration and Power of Attorney, which was filed on June 13, 2003. However, the Examiner has not yet commented on Applicants comments. It is therefore respectfully requested that the Examiner respond on the record in this regard. Based upon the previously submitted arguments, reconsideration and withdrawal of this objection are requested.

Issues Under 35 U.S.C. §102(b)/103(a)

The Examiner has rejected claims 1 and 9-14 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over either JP 2000-10233 (which is equivalent to United States Patent Number 6,165,707 issued to Hirano and hereinafter referred to as Hirano '707) or U.S. Patent No. 6,100,022, issued to Inoue et al. (hereinafter referred to as Inoue '022).

The Examiner has also rejected claims 1 and 4-15 under 35 U.S.C. §102(b) as being anticipated by JP 2000-112072 (hereinafter referred to as JP '072).

The Examiner has also rejected claims 1-16 and 18-20 under 35 U.S.C. §103(a) as being obvious over JP '072.

Lastly, the Examiner has rejected claim 17 under 35 U.S.C. §103(a) as being obvious over JP '072 in view of Ito et al, U.S. Patent No. 6,150,084 (hereinafter referred to as Ito '084).

Applicants respectfully traverse each of the above rejections.

Applicants hereby incorporate all arguments previously made.

Distinctions Between the Present Invention and the Cited Art

Applicants respectfully submit that none of the references cited by the Examiner suggest or disclose condition (I) or condition (II) as required by the present claims. Applicants have previously submitted Declarations on November 22, 2002 (the

Nakano Declaration) and November 7, 2003 (the Oikawa Declaration). Based upon these Declarations, in particular the Oikawa Declaration, it can be concluded that none of the primary references cited by the Examiner inherently meet Condition I or Condition II, according to the present claims. As such, the Examiner's anticipation rejections are moot. The primary references fail to suggest or disclose either Condition I or Condition II, thus, without inherent disclosure (which was shown by the Oikawa Declaration to be absent), there can be no anticipation. Further, absent inherent disclosure, the lack of any motivation (such as might be provided by explicit disclosure) to arrive at Condition I or Condition II, will prevent a proper *prima facie* case of obviousness. Applicants will discuss this further below:

Claim 1 of the present invention, upon which all other claims depend, relates to a photothermographic material. This material must satisfy at least one of Condition I or Condition II. Condition I includes the limitation that

the  $\text{NH}_4^+$  content in all the layers formed on the image-forming layer side of the support is  $0.06 \text{ mmol/m}^2$  or less

Condition II includes the limitation that the

film surface pH of the image-forming layer side of the support is substantially unchanged after coating, and the layers formed on the image-forming layer side of the support do not substantially contain ammonia

Condition I or Condition II includes limitations concerning specific compounds and specific amounts of ammonium ion or ammonia in the layers on the image-forming layer side of the support. If the cited art does not meet these limitations, there can be no inherency as suggested by the Examiner. Moreover, absent some motivation to achieve these amounts of ammonium ion or ammonia, there exists no *prima facie* case of obviousness. And even if there is hypothetically a *prima facie* case of obviousness, a point not conceded by Applicants, the presently claimed subject matter achieves superior results not expected from the cited art, thus rebutting any hypothetical *prima facie* case of obviousness.

Applicants request that the Examiner again review the Oikawa Declaration. In the Advisory Action dated November 25, 2003, the Examiner stated indicated that he does not believe that the Declaration addresses issues concerning unexpected results. However, the Declaration was provided in order to show the lack of inherency in the present claims based upon the cited art. Unexpected results are not relevant to overcoming an anticipation rejection based upon inherency. Moreover, as discussed above in part, once it is established that a reference does not inherently disclose certain subject matter recited in a claim, any *prima facie* case of obviousness is unlikely since without specific disclosure or inherent disclosure, the reference cannot suggest the claimed limitation to one of ordinary skill in the art.

During a telephone Interview conducted with the Examiner on January 6, 2003, the Examiner requested that Applicants provide a Request for Reconsideration and outline (1) why the cited art does not meet Condition I or Condition II, and (2) what aspect of the present claims allows the invention to achieve Condition I and Condition II.

1. The primary references do not disclose, either explicitly or inherently, Condition I or Condition II.

The primary references cited by the Examiner are Inoue '022, Hirano '707 and JP '072. In the Oikawa Declaration, three samples (Samples 1, 2, and 3) are tested. Sample 1 was prepared according to Example 1 of Inoue '022, one of the primary references). Sample 2 was prepared according to Examples 1-2 of Hirano '707, another one of the primary references. Lastly, Sample 3 was prepared according to Sample 3 shown in Table 1 of JP '072.

A review of the results for each of Samples 1, 2 and 3 reveal that the amounts of ammonium ion in all the layers formed on the image forming side are outside of the claimed ranges. Samples 1, 2 and 3 contained 0.24, 0.26 and 0.23 mmol/m<sup>2</sup>, respectively, of ammonium ion in all the layers formed on the image forming layer side. However, Condition I of the claims requires that the amount of ammonium ion in all the layers formed on the image-forming layer side of the support be 0.06 mmol/m<sup>2</sup> or less. Condition II of the claims requires that the layers formed

on the image-forming layer side of the support do not substantially contain ammonia. Neither of these conditions is achieved by the cited art.

Accordingly, the cited references of Inoue '022, Hirano '707 and JP '072 fail to achieve the presently claimed subject matter. The references also lack any explicit disclosure of Condition I or Condition II, thus no anticipation exists. Additionally, there also exists no *prima facie* case of obviousness. Specifically, there exists no motivation in any of the references including the secondary reference of Ito '084 to achieve the presently claimed subject matter. Thus, the Examiner has failed to present a valid *prima facie* case of obviousness.

However, even if the Examiner has hypothetically established a *prima facie* case of obviousness, a point not conceded by Applicants, Applicants submit that the presently claimed subject matter achieve unexpectedly superior results compared to the cited art.

None of the art cited by the Examiner suggests or discloses that by utilizing specific compounds and specific amounts of ammonium ions, that lower temperature and lower humidity dependency would result. As shown in the Table 1 of the present specification, the claimed invention shows much lower temperature and humidity dependency than samples No. 1-3 and No. 1-8. Applicants submit that one skilled in the art could not have

expected that such excellent effects could be obtained by satisfying Condition I of the claimed invention.

Also, as shown in Table II of the present specification, the claimed invention shows much lower temperature and humidity dependency than comparative samples that do not satisfy Condition II. Applicants submit that one skilled in the art could not have expected that such excellent effects could be obtained by satisfying Condition II of claimed invention.

2. The present invention achieves Condition I or Condition II

The Examiner has requested that Applicants prove why Condition I or Condition II is met by the present invention, but not by the prior art. Applicants submit that it has been shown above that the prior art fails to satisfy either Condition I or Condition II. Further, there is no requirement that Applicants provide why Condition I or Condition II are met by the present invention. In fact, it is the fact that Applicant's invention satisfies Condition I or Condition II, which distinguishes it from the cited art. In other words, it is in Condition I or Condition II that the limitations exist which allow the present invention to achieve superiority over the prior art. Direct comparison with the primary reference is unnecessary since it has already been shown that the references do not satisfy Condition I or Condition II. As such, and as outlined in the specification,

materials which do not meet these Conditions are not able to achieve the superior results of the present invention.

One of the features of the present invention that can contribute to lowering the temperature or humidity dependency during development, resides in the  $\text{NH}_4^+$  content. Specifically, the  $\text{NH}_4^+$  content in all in all the layers formed on the image-forming layer side is limited to  $0.06 \text{ mol/m}^2$  or less, as required by Condition I. Another feature of the present invention is that the layers formed on the image-forming layer side do not substantially contain ammonia, so as to not change the film pH of the image-forming layer side, as required by Condition II.

The present inventors have found that when ammonia is present in the layers formed on the image-forming layer side, the film surface pH of the image-forming layer side or the like varies depending on the temperature or humidity during development. Such variations influence the ability of the particular nucleating agents defined in claim 1. According to the present invention, the particular nucleating agents are utilized under either Condition I or Condition II. Consequently, the temperature or humidity dependency during development can be reduced according to the present invention.

Without the disclosure of Condition I or Condition II, in conjunction with the presently claimed compounds, the prior art is not able to achieve the reduced temperature and humidity dependency properties of the present invention. Accordingly,



there exists neither anticipation nor obviousness, based upon the cited art.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the cited art. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please do not hesitate to contact Craig A. McRobbie, Reg. No. 42,874, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to January 12, 2004 in which to file a reply to the Office Action. The required fee of \$420.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional

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fees required under 37 C.F.R. § 1.16 or under § 1.17;  
particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner  
Reg. No. 32,181

Craig A. McRobbie  
Reg. No. 42,874

MSW/CAM/mmi  
2870-0171P

P. O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000